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BY:

Vicky Neri

Date:

January 8, 2004

MAIL STOP NON FEE AMENDMENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of:
Sean Mullaney et al.

Conf. No.: 2386

: Group Art Unit: 3712

Appln. No.: 10/068,973

: Examiner: Ali F. Abdelwahed

Filing Date: February 7, 2002

: Attorney Docket No.: 4110-163US

Title: Remote-Controlled Tractor Trailer Toy

PETITION UNDER 37 C.F.R. § 1.144

Applicants hereby petition for withdrawal of the restriction requirement imposed by the Examiner in his communication dated August 7, 2003 (Paper No. 6) and traversed by Applicants in a response filed by facsimile on September 8, 2003 (Paper No. 8).

Subsequent to Applicants' election with traverse, the Examiner issued a first substantive action mailed October 8, 2003 (Paper No. 8). In that action, the Examiner did not repeat or otherwise make final the restriction requirement but did withdraw the unelected claims 13-24 from consideration and examined only the elected claims 1-12. On November 13, 2003 Applicants filed by facsimile a Request For Complete Office Action (Paper No. 9). In that Request Applicants noted that:

(the) Office Action dated October 8, 2003 (Paper No. 8) ... does not respond to or even acknowledge Applicants' traverse of restriction election requirements with respect to the claims in the above-identified application. The Examiner is hereby called upon to issue a new non-final action responding to Applicants' traversal of the restriction election requirements.

The Examiner failed to respond verbally or in writing to that request. The Examiner further failed to respond to a follow-up telephone request and voice mail message left with him on December 3, 2003.

In a telephone conference with Examiner Abdelwahed on January 7, 2004, the Examiner Abdelwahed told me that he was aware of my requests but that he was told by his supervisory examiner, Derris Banks, that he did not need to respond. Apparently Examiner Abdelwahed misunderstood Mr. Banks' comments. Examiner Abdelwahed proceeded to treat the restriction and election requirements as final without formally notifying Applicants.

The application was filed with 24 claims: independent claims 1, 13 and 20 and dependent claims 2-12, 14-19 and 21-24, respectively. The application discloses but one device, a remotely controlled tractor trailer toy vehicle configured in a way such that the tractor portion of the vehicle can actually turn under the trailer portion of the vehicle.

Independent claims 1, 13 and 20 are reproduced and attached hereto. The patent discloses a single embodiment remotely controlled tractor trailer toy vehicle in its Figures 1-13 as well as the hand operated remote control unit for the vehicle in Figures 14 and 15. The election/restriction in the August 7, 2003 Office Action was as follows:

Elections/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

(i) *Claims 1-12, drawn to a toy vehicle, classified in class 446, subclass 434.*

(ii) *Claims 13-14, are drawn to an articulated toy vehicle, classified in class 446, subclass 431. The inventions are distinct, each from the other because of the following reasons:*

Inventions I and II are related as combination and sub-combination. Inventions in this relationship are distinct if it can be shown that (i) the combination as claimed does not require the particulars of the sub-combination as claimed for patentability, and (ii) that the sub-combination has utility by itself or in other combinations (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the sub-

combination as claimed because the combination does not require "... a powered operating assembly configured to at least steer the tractor from a forward facing position to a rearward facing position ...". The sub-combination has separate utilities such as a steering assembly for use in the vehicle.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

RESPONSE

The Examiner asserts that inventions I. and II. are related as combination and sub-combination. This characterization of the claims is unsupported. The Examiner cannot show that the elements of one of the independent claims 1, 13 or 20 are fully present in the other of those claims so as to constitute a sub-combination of that other claim. In particular, each claim calls for two vehicle components, either a tractor and trailer in claim 1 or a first vehicle portion and a second vehicle portion in claims 13 and 20. Each of claims 1 and 13 calls for two hitch mechanisms, one associated with the first vehicle/tractor, the other associated with the second vehicle/trailer. Claim 20 calls for an articulated coupling between the first and second vehicle portions. The claims are thus coextensive insofar as they both claim the same significant elements. The vehicle portions are more particularly identified in the claims 1 and 20 and are left more generally described in claim 13 whereas the hitch components are more particularly described in claim 13 and left more generally described in claims 1 and 20. This does not make either a sub-combination of the other.

Applicants further traverse the Examiner's conclusion that claims 13-24 would not be classified under subclass 434 of class 446. The definition of subclass 434 is:

Tractor or Trailer:

Subclass 434. Device comprising either (1) a simulation of an on- or off-road vehicle which is specifically adapted to draw another vehicle or a piece of equipment, or (2) a simulation of an on- or off-road vehicle adapted to be drawn by another vehicle.

Independent claim 13 is directed to first and second vehicle portions having first and second hitches, respectively, connected thereto wherein the first hitch is configured in a particular, claimed configuration "for coupling with the second hitch assembly." It is respectfully submitted

that the requirements for two vehicle portions and first and second hitches, coupling with one another, satisfies the requirement of this subclaim for a vehicle “specially adapted to draw ... or ... be drawn by another vehicle.” There is but one toy vehicle embodiment described, a toy tractor-trailer combination, which is literally read upon by all of the claims including claim 13.

Independent claim 20 specifically calls for first and second vehicle portions “having a plurality of road wheels” and “an articulated coupling between the first vehicle portion and the second vehicle portion.” Claims 21-23 are directed to the provision of motors in at least one of the two vehicle portions drivingly coupled with one or more of the road wheels of the two vehicle portion. These claims clearly fall within subclass 434.

Finally, the restriction requirement is clearly unsupported in view of MPEP § 806.03 which states:

806.03 Single Embodiment, Claims Defining Same Essential Features

Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

The application describes but a single embodiment. As explained above, the presented independent claims 1, 13 and 20 claim the same essential elements and vary in scope only with respect to those individual essential element characteristics. Accordingly, the restriction is unsupported.

For the foregoing reasons, the Examiner has failed to show that any of the independent claims represents a sub-combination of any other independent claim or that the claims are distinct based upon classification. Given that the independent claims all read upon and define the same essential characteristics of the single disclosed embodiment of the invention, restriction among the claims is absolutely not supported. M.P.E.P. 806.03.

For these reasons, the restriction requirement should be withdrawn and claims 13 through 24 should be examined. It is believed these claims are also allowable over the prior art of record in this application.

Respectfully submitted,

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9 Jun. 2004
(Date)

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Attachments [independent claims 1, 13 and 20]

INDEPENDENT CLAIMS

1. A toy vehicle comprising:

a tractor having a tractor body, an operating assembly including a chassis connected to the tractor body for steering the tractor at least from a forward facing position to an opposite rearward facing position, and a tractor hitch assembly connected to the chassis;

a trailer having a trailer body and a tongue extending therefrom, and a trailer hitch assembly connected to the trailer tongue and being couplable with the tractor hitch assembly such that the tractor can rotate at least from the forward facing position to the opposite rearward facing position under the trailer tongue.

13. An articulated toy vehicle comprising:

a first vehicle portion having a first hitch connected thereto;

a second vehicle portion having a second hitch connected thereto;

the first hitch comprising a generally spherical base member and a first connector member extending from the base member, and a housing connected to the first vehicle portion, the housing having a generally spherical socket for receiving the base member and an opening through which the first connector member extends for coupling with the second hitch assembly.

20. An articulated toy vehicle comprising:

a first vehicle portion having a plurality of road wheels;

a second vehicle portion having a plurality of road wheels; and

an articulated coupling between the first vehicle portion and the second vehicle portion;

the first and second vehicle portions and the articulated coupling being configured and positioned such that the first vehicle portion can be rotated at least 360° around the articulated coupling and completely beneath the second vehicle portion at least essentially

without interference between the first and second vehicle portions with all of the road wheels of the first and second vehicle portions supported by a level surface beneath the vehicle.